



Applicants respectfully point out that anticipation requires identity. "The claimed invention, as described in the appropriately construed claims, must be the same as that of the reference in order to anticipate." *Glaverbel Société Anonyme v. Northlake Marketing & Supply Inc.*, 33 USPQ2d 1496, 1498 (Fed. Cir. 1995). Furthermore, "when a claimed invention is not identically disclosed in a reference, and instead requires picking and choosing among a number of different options disclosed by the reference, then the reference does not anticipate." *Mendenhall v. Astec Industries, Inc.*, 12 USPQ2d 1913, 1928 (Tenn. 1988), *aff'd*, 13 USPQ2d 1956 (Fed. Cir. 1989). To date, Applicants have been unable to find any precedent that allows anticipation to stand based on substantially identical to the invention.

Applicants understand Wang to disclose an iridescent film overlaid on a substrate member and a filler layer formed beneath the substrate member (column 1, line 37-line 40). The iridescent material is translucent or transparent (column 2, lines 6 and 7).

Further, the iridescent material includes a laminated film consisting of a plurality of transparent or translucent thin membranes laminated and superimposed on one another,

and outer and inner transparent layers (column 2, lines 19-32). Substrate member and filler layer may be selected from plastic or rubber materials (column 2, line 16 to line 18).

Wang does not disclose a fragile layer as required by Claims 1 and 2 of the present application. Nor does Wang disclose or suggest a transparent layer that is fragile. ✓

Applicants have described "fragile" as a mechanically weak material. Wang discloses a 3-D decorative object feature having projections and the overlaid iridescent film by its description cannot be mechanically weak, since it is being used as a layer to prevent scratching. Furthermore, the laminate described in Wang is molded or welded.

Furthermore, Wang does not disclose printed identification or verification information as claimed in Claims 1 and 2. Nor is there any security element in Wang.

Wang fails to disclose a mechanically fragile layer, printed identification or a security element, yet the Examiner states that Wang anticipates because the reference is generally similar to the present invention. Applicants respectfully submit that there is very little similarity other than the cited reference discloses a laminate and the present invention claims a laminate.

Applicants respectfully submit that Wang fails to anticipate the present invention for failure to identically disclose the present invention. In view of the foregoing comments, Applicants respectfully request the Examiner withdraw all 35 U.S.C. § 102(b) rejections from Claims 1, 2 and 14, a claim dependent from Claim 1.

The Examiner has further stated that Wang “inherently teaches the methods of claims 23 and 24.”

Applicants respectfully submit that the rejection of claims 23 and 24 is improper. The Examiner has rejected the claims on the basis of 35 U.S.C. § 102(b) on a theory of inherency. However, it is well understood that inherency and obviousness are distinct concepts. That which may be inherent is not necessarily known and obviousness cannot be predicated on what is unknown. *In re Newell*, 13 USPQ2d 1248. 1250 (Fed. Cir. 1989). Therefore, Applicants respectfully submit that which is unknown in Wang (i.e., molding process v. printing process) cannot teach the methods of Claims 23 and 24.

In addition, Claim 23 claims a process for manufacturing a transparent data sheet that includes the step of “(1) providing a printable surface of a first fragile layer”. Wang does not disclose a printable surface or a first fragile layer. Further yet, Wang fails to disclose a second fragile layer. A molding process and not a printing process form the decorative items in Wang.

Claim 24 claims a process of manufacturing a transparent data sheet that includes the step of “(1) printing identification information”. Wang does not disclose a printing process, but rather a molding process.

Applicants respectfully submit Wang also fails to anticipate Claims 23 and 24. Applicants respectfully request the Examiner withdraw all 35 U.S.C. § 102(b) rejections to Claims 23 and 24.

Rejections under 37 U.S.C. 103(a)

Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang. The Examiner alleges Wang discloses the claimed invention except for claimed layer materials. The Examiner asserts it would have been obvious to one having ordinary skill in the art at the time the invention was made to use any suitable material, since it has been held to be within the general skill level of a worker in the art to select a known

material on the basis of its suitability for the intended use as a matter of obvious design choice.

Applicants respectfully point out that “before obviousness can be established, the Examiner must show that there is either a suggestion in the art to produce the claimed invention or a compelling motivation based on sound scientific principles. Logic compels that the suggestion or motivation be accompanied by a general knowledge of the existence of art-recognized techniques for carrying out the proposed invention.” *Ex parte Krantz*, 19 USPQ2d 1216, 1218 (BPAI 1990).

The Examiner has stated that the present invention is obvious over Wang because it would have been obvious to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. Applicants respectfully ask the Examiner to be more specific and clarify “suitable for what purpose”. The invention taught in Wang is to a decorative 3D article. The present invention is to a security data page. Applicants are unclear how reading Wang teaches Applicants about the present invention. There is no teaching in Wang regarding data pages, fragile hot stamp foils or security elements.

Claim 9 claims the transparent data sheet of Claims 1 or 2 wherein the transparent fragile layer is a multilayered polyurethane film. Claims 10 to 12 claim the transparent data sheet of Claim 1 wherein the data durable film is further defined.

Even if one assumes that it may be obvious to one of ordinary skill in the art at the time the invention was made to use materials of Claims 9 to 12 in the invention of Claim 1, combining the materials of any one of Claims 9 to 12 with the elements disclosed in Wang does not arrive at all of the limitations of these claims. Nowhere does Wang disclose or suggest a transparent fragile layer, printed identification or verification information, or a security element, all elements claims by independent Claims 1 and 2.

Applicants respectfully submit that Wang fails to make the present invention obvious. Thus, Applicants respectfully request the Examiner withdraw all 35 U.S.C. § 103(a) rejections from claims 9 to 13.

Claims 3, 5, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of Killey. The Examiner asserts that Wang discloses the claimed invention

except for a holographic foil layer, and that Kelley teaches that it is well known in the art to use a holographic foil layer in its assembly. The Examiner also believes it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Wang with a holographic foil layer in the manner as taught by Killey in order to enhance the security feature.

Applicants respectfully submit that in order for the references to be combined, there must be teachings in the reference only if there is some suggestion or incentive to do so. *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Applicants respectfully submit the Examiner has failed to provide any motivation or suggestion to combine the two references. The Examiner states that Wang discloses the invention except for the holographic foil (a statement Applicants firmly believe is in error) and that the holographic foil of Killey can be used in a manner as taught by Killey to enhance the security feature. Applicants submit that Wang does not disclose, teach or otherwise make known a security feature in the description of the 3D decorative article. Without the claims of the present invention serving as a roadmap, there is no incentive to add a holographic foil to the article of Wang and there appears to be no security feature in Wang to enhance.

Applicants submit that Wang in view of Killey fails to make the present invention obvious. Furthermore, Applicants submit that Wang alone fails to make the present invention obvious and Killey fails to cure the fatal flaw that Wang does not describe the present invention. In addition, claims 3, 5 and 18 are dependent claims from Claims 1 or 2, which Applicants believe are allowable in view of the art cited.

Claims 4, 6, 7, 13, 15, 16, 19, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of McConville et al. The Examiner states that Wang discloses the invention except for the retroreflective layer of glass beads (a statement Applicants firmly believe is in error) and that the retroreflective layer of glass beads of McConville can be used in a manner as taught by McConville to enhance the security feature. Applicants submit that Wang does not disclose, teach or otherwise make known a security feature in the description of the 3D decorative article. Without the claims of the present invention serving as a roadmap, there is no incentive to add



retroreflective layer of glass beads to the article of Wang and further, there appears to be no security feature in Wang to enhance.

Applicants submit that Wang in view of McConville fails to make the present invention obvious. Furthermore, Applicants submit that Wang alone fails to make the present invention obvious and McConville fails to cure the fatal flaw that Wang does not describe the present invention. In addition, claims 4, 6-7, 13, 15-16, and 19-21 are dependent claims from Claims 1 or 2, which Applicants believe are allowable in view of the art cited.

CONCLUSION

Applicants respectfully suggest this paper is fully responsive to the Office Action and the remarks and amendments have resolved the Examiner's outstanding objections and rejections. However, if after fully considering Applicants' response, there are issues remaining, Applicants request the Examiner telephone the undersigned to timely resolve any remaining issues.

Please charge any fees that may be associated with this paper to Deposit Account No. 13-3723.

Respectfully Submitted,

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